

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 10-19 are pending in this application. Claim 10 and 19 are independent. The remaining claims depend, directly or indirectly, from claim 10.

Objections

The drawings were objected to for not showing a selected clearance between an external stab flank and an internal stab flank, which was recited in claim 10 as amended in the previous response. Claim 10 has been amended in the present reply to delete the selected clearance. Thus, this objection is now moot. Withdrawal of this objection is respectfully requested.

Rejections under 35 U.S.C § 112

Claims 10-19 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

With respect to the rejection as it applies to claim 10, lines 9-10, which recites that “irreversible plastic deformation of the positive stop torque shoulder does not occur upon final makeup,” Applicant respectfully asserts that this limitation is consistent with page 6, lines 1-2 of the originally filed specification, which states that torque “may be

applied to the positive stop torque shoulder prior to final make up, without causing irreversible plastic deformation.” “To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” MPEP § 2163(I). If no irreversible plastic deformation occurs *prior* to final makeup as recited in the specification, no irreversible plastic deformation would occur *upon* final makeup as it would be impossible to have irreversible plastic deformation at exactly final makeup. Thus, Applicant’s description of avoiding irreversible plastic deformation prior to final makeup is sufficient for one skilled in the art to conclude that no plastic deformation would occur upon final makeup. Accordingly, the two statements are consistent and satisfy the written description requirement. Withdrawal of this rejection is respectfully requested.

With respect to the rejection as it applies to claim 10, lines 11-12, which recites that a “clearance exists between the external stab flank and the internal stab flank,” claim 10 has been amended to delete this limitation. Thus, this rejection is now moot. Accordingly, withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C § 102

Claims 10, 11, and 15-19 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,462,315 (Klementich). Claim 10 was amended in the previous reply to the Office Action dated June 10, 2004, to clarify the present invention. Applicant respectfully notes that the patentability of claim 10 as amended in the previous reply was not fully considered by the Examiner under all relevant statutory provisions.

MPEP § 2163(III). Applicant respectfully requests that the Examiner fully consider the patentability of amended claim 10 and its dependents. To the extent that the Examiner maintains the rejection to amended claim 10, the rejection is respectfully traversed.

Claim 10 was previously amended to include the limitation that “a torque is applied such that irreversible plastic deformation of a torque shoulder does not occur upon final makeup.” Support for this amendment is found at least in paragraphs 26 and 31 of the specification as originally filed. As amended, claim 10 recites that a *torque* is applied during makeup so as to avoid causing irreversible plastic deformation to the torque shoulder.

In Klementich, for example, irreversible plastic deformation occurs when the connection is made up. *See* col. 16–17. “Upon final power tightening (torquing) of the assembled connection, the leading surface of shoulder 520 contacts first undercut surface 548 on box center should configuration 530, while the leading surface of shoulder 540 contacts second undercut surface 528 on pin center shoulder configuration 500, thereby creating two additional zero clearance, metal to metal sealing surfaces.” Col. 22, ll. 45–51. It is apparent that Klementich discloses making up the connection until *irreversible* plastic deformation occurs, in contrast to the presently claimed invention. In the method of the present invention, the torque is *selected* to avoid this very phenomenon. The present inventors have advantageously discovered that by avoiding irreversible plastic deformation of the positive stop torque shoulder, the life of a connection may be increased, without a significant loss in performance.

Because Klementich fails to show or suggest all of the limitations found in amended claim 10, it fails to anticipate or render obvious amended claim 10. Thus,

withdrawal of this rejection is respectfully requested. Claims 11 and 15-19, which depend from claim 10, are patentable for at least the same reasons.

Rejections under 35 U.S.C § 103

Claims 12-14 were rejected under 35 U.S.C. § 103 as obvious over Klementich in view of U.S. Patent No. 4,822,081 (Blose). Claim 10, from which claims 12-14 depend, was amended in the previous reply as discussed above. To the extent that the Examiner maintains the rejection to claims 12-14, the rejection is respectfully traversed.

As discussed above, Klementich fails to show or suggest the avoidance of plastic deformation of the positive stop torque shoulder. Blose neither shows nor suggests that which Klementich lacks with respect to amended claim 10. Further, Blose discloses the selective use of plastic deformation to strengthen the connection and improve sealing (column 4, lines 28-66). Thus, Blose teaches away from the Examiner's proposed combination with Klementich and reinforces Applicant's assertion that selecting a torque to avoid plastic deformation of a positive stop torque shoulder is novel and non-obvious.

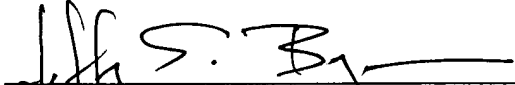
In view of the above, Klementich and Blose, whether considered separately or in combination, fail to show or suggest the present invention as recited in amended claim 10. Thus, the amended claim 10 is patentable over Klementich and Blose. Dependent claims 12-14 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09432/183002).

Respectfully submitted,

Date: 3/22/05



Jeffrey S. Bergman, Reg. No. 45,925
OSHA & MAY L.L.P.
One Houston Center, Suite 2800
1221 McKinney Street
Houston, TX 77010
Telephone: (713) 228-8600
Facsimile: (713) 228-8778

94097_2.DOC